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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/811,845	03/19/2001	Thomas E. Chefalas	YOR920010017US1	9247

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EXAMINER

FOWLKES, ANDRE R

ART UNIT	PAPER NUMBER
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2122

DATE MAILED: 10/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/811,845

Applicant(s)

CHEFALAS ET AL.

Examiner

Andre R. Fowlkes

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 6/21/04.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-61 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-61 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. This action is in response to the amendment filed on 6/21/04.
2. The objections to the specification are withdrawn, in view of applicants amendment.
3. The objection to claim 29 is withdrawn, in view of applicants amendment.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-10, 12-32, and 34-61 are rejected under 35 U.S.C. 102(b) as being anticipated by May et al. (May), U.S. Patent No. 5,809,251.

As per claim 1, May discloses **a method for automatically downloading and installing software to a computer system**, (col. 2:8-10, "remote installation of ... software is forwarded by a management information system into a remote computer"), **comprising the steps of:**

- **receiving an instruction from a client computer to install an item of software on the computer system** (col. 1:9-13, "Management information systems (MIS) are used to manage computing devices by monitoring and checking inventory,

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taking the current status of machine configurations (i.e. a machine in the status needing new software has its status sent to the MIS and the MIS is instructed to install the item of software”),

- collecting data about the computer system to form collected data (col. 1:9-13, “Management information systems (MIS) are used to manage computing devices by monitoring and checking inventory, taking the current status of machine configurations),

- based on the collected data, determining whether the item of software can be installed on and executed by the computer system (col. 1:9-13, “Management information systems (MIS) are used to manage computing devices by monitoring and checking inventory, taking the current status of machine configurations, such as current memory configurations, hard drive capacity, RAM, CPU”, and this data is used to determine whether the resources on the computer are sufficient to run the update (i.e. new item of software)),

- if the item of software can be installed on and executed by the computer system, based on the collected data, downloading a proper version of the item of software from a server and installing the proper version (col. 8:8-10, “the MIS system begins to download the (proper version of the) new files to the remote computer (to be installed)”)),

- based on the collected data, setting configuration options associated with the proper version (col. 1:61-63, “Based on this information, MIS managers can schedule upgrades for outdated ... software configurations”).

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As per claim 2, the rejection of claim 1 is incorporated and further, May discloses **based on the collected data, determining whether the item of software can be installed on the computer system, and if the item of software cannot, then ending execution of the method** (col. 1 lines 9-12, "Management information systems (MIS) are used to manage computing devices by monitoring and checking inventory, taking the current status of machine configurations (i.e. collected data)", and col. 2 lines 17-19, "the management information system (analyzes the collected data to determine if an item of software can/should be installed)").

As per claim 3, the rejection of claim 1 is incorporated and further, May discloses **submitting the collected data to a server** (col. 2 lines 16-18, "the management information system (MIS) requests (collected data, and it is submitted to the MIS)", and col. 1 lines 14-16, "An MIS console ... generally utilizes a desktop management interface (DMI) located within ... a server") **and receiving an analysis of the collected data, wherein the analysis specifies the proper version and the configuration options** (col. 2 lines 18-20, "(the collected data is analyzed and proper version of software to be installed is specified)").

As per claims 4 and 5, May also discloses such claimed limitations as addressed in claims 3 and 9, respectively.

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As per claim 6, the rejection of claim 1 is incorporated and further, May discloses **receiving the instruction via one of a wireless network, a local area network, an Internet, an intranet, and a wide area network** (col. 3 lines 45-50, "interconnection may include one, or a combination of, a local area network, a wide area network, the internet, the world wide web, a public telephone system, ..., radio frequency transmission, a cellular phone system, and so on").

As per claim 7, May also discloses such claimed limitations as addressed in claim 29, below.

As per claim 8, the rejection of claim 7 is incorporated and further, May discloses that **the method is executed on a server** (col. 1 lines 14-16, "An MIS console (which executes the method), ... generally utilizes (components that can be executed on a) ... server").

As per claim 9, the rejection of claim 7 is incorporated and further, May discloses **receiving at least one confirmatory message from the at least one software installation agent** (col. 8 lines 10-12, "(The software installation agent on) the remote computer displays a note to the user about the results of the action").

As per claim 10, the rejection of claim 7 is incorporated and further, May discloses **receiving the instruction from a remote computing device via the**

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network (col. 1 lines 64-65, "an MIS has been used effectively to manage PCs and servers interconnected by a ... network", and computers connected in a network send and receive instructions with each other).

As per claim 12, May also discloses such claimed limitations as addressed in claim 6, above.

As per claim 13, the rejection of claim 7 is incorporated and further, May discloses **based on the user input, choosing** software installation/configuration options, (col. 10 lines 2-3, "(software installation/configuration options) can be ... (changed) by a user).

As per claim 14, the rejection of claim 7 is incorporated and further, May discloses **transmitting the at least one software installation agent to the at least one computer system to be installed by a user** (col. 1 lines 15-16, "a desktop management interface (which contains agent(s) is) located within each PC or server", and since the PC's and servers are connected in a network, they may transmit agents amongst themselves).

As per claims 15-24 and 26-28, this is a product version of the claimed method discussed in claims 1-10 and 12-14, wherein all claimed limitations also have been

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addressed above and such a product is deemed to be inherent in the May remote software installation system, otherwise it would be inoperative.

As per claim 29, May discloses **a network; a server connected to the network; a client computer connected to the network; and at least one target computer connected to the network** (col. 1 lines 64-65, "an MIS has been used effectively to manage PCs and servers interconnected by a ... network"), **wherein each of the at least one target computer executes a software installation agent**, (col. 1 lines 15-16, "a desktop management interface (which contains agent(s) is) located within each PC"), **wherein the client computer submits a request to the server, responsive to receiving the request the server schedules an appropriate time to install an item of software** (col. 1 lines 34-35, "(client computers send requests to servers)", and col. 2 lines 8-9, "(the server schedules) remote installation of ... software ... into a remote computer"), **at the appropriate time the server notifies the software installation agent on each of the at least one target computer that the item of software is to be installed, the software agent on each of the at least one target computer collects data about the at least one target computer to make a determination if and how the item of software can be installed and configured** (col. 2 lines 15-18, "(at the appropriate time), the management information system (uses agents to collect data about the target computer to determine what software should be installed)"), **based on the determination the software installation agent on each of the at least one target computer downloads, installs, and configures the item of**

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software on each of the at least one target computer (col. 2 lines 8-10, "(based on the analysis of the collected data), remote installation of ... software is (downloaded, installed, and configured on a target computer)").

As per claims 30-32, May discloses such claimed limitations as addressed in claims 6, 3 and 29 above, respectively.

As per claims 34-39, this is an apparatus version of the claimed method discussed in claims 1-6, wherein all claimed limitations also have been addressed above and such an apparatus is deemed to be inherent in the May remote software installation system, otherwise, it would be inoperative.

As per claim 40, this is an apparatus version of the claimed system discussed in claim 29, wherein all claimed limitations also have been addressed above and such an apparatus is deemed to be inherent in the May remote software installation system, otherwise, it would be inoperative.

As per claim 41-43 and 45-47, May also discloses such claimed limitations as addressed in claims 8-10 and 12-14.

As per claims 48-53, this is another system version of the claimed method discussed in claims 1-6, wherein all claimed limitations also have been addressed

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above and such an apparatus is deemed to be inherent in the May remote software installation system, otherwise, it would be inoperative.

As per claim 54-57 and 59-61, this is another system version of the claimed method discussed in claims 8-10 and 12-14, wherein all claimed limitations also have been addressed above and such an apparatus is deemed to be inherent in the May remote software installation system, otherwise, it would be inoperative.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 11, 25, 33, 44 and 58 are rejected under 35 U.S.C. 103(a) as being unpatentable over May et al. (May), U.S. Patent No. 5,809,251 in view of applicants admitted prior art (AAPA).

As per claim 11, the rejection of claim 10 is incorporated and further, May doesn't explicitly disclose **receiving the instructions through a Hyper-Text Markup Language (HTML) interface.**

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However, AAPA, in an analogous environment, discloses **receiving the instructions through a Hyper-Text Markup Language (HTML) interface** (p. 2 lines 16-17, "Retrieval of information on the web is generally accomplished with an HTML-compatible browser").

Therefore, it would have been obvious to a person of ordinary skill in the art, at the time the invention was made, to incorporate the teachings of AAPA into the system of May **to allow the transferring of instructions using HTML**. The modification would have been obvious because one of ordinary skill in the art would want guarantee that any browser can communicate with any web server on the World Wide Web, by using standard HTML syntax and the standard communications protocol, HTTP (AAPA, p. 3 lines 3-5).

As per claims 25, 44 and 58, May also discloses such claimed limitations as addressed in claim 11, above.

As per claim 33, the rejection of claim 29 is incorporated and further, May doesn't explicitly disclose **submitting requests using a HyperText Transfer Protocol (HTTP)**.

However, AAPA, in an analogous environment, discloses **submitting requests using a HyperText Transfer Protocol (HTTP)** (p. 2 lines 24-25, "The browser then issues a hypertext transfer protocol (HTTP) request").

Therefore, it would have been obvious to a person of ordinary skill in the art, at the time the invention was made, to incorporate the teachings of AAPA into the system

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of May to **allow the transferring of instructions using HTML**. The modification would have been obvious because one of ordinary skill in the art would want guarantee that any browser can communicate with any web server on the World Wide Web, by using standard HTML syntax and the standard communications protocol, HTTP (AAPA, p. 3 lines 3-5).

Response to Argument

6. Applicant's arguments filed 6/21/04 have been fully considered but they are not persuasive.

In the remarks, the applicant has argued substantially that:

1) May does not teach where the client computer submits a request to the server and collecting data about the target computer to make a determination if and how the item of software can be installed and configured, on p. 17, ¶ 3:11-14.

Examiner's response:

1) May does teach the limitations above, as addressed in the rejection of amended claim 1, above.

In the remarks, the applicant has argued substantially that:

2) Only updates of already installed software are remotely installed by the management information system, on p. 18, ¶ 2:3-4.

Examiner's response:

2) The examiner disagrees with the applicants characterization of the applied art. While, May does disclose installing software updates, these software updates are, in effect, new software for the computer system. Software upgrades often have more, or different, hardware and configuration requirements, than their predecessors. Additionally, it is often strongly recommended by software manufacturers, that the old software be removed and that a completely new installation is performed, to obtain desired software operation.

In the remarks, the applicant has argued substantially that:

3) AAPA does not teach where the client computer submits a request to the server and collecting data about the target computer to make a determination if and how the item of software can be installed and configured.

Examiner's response:

3) May does teach these limitations as addressed in the rejection of amended claim 1, above.

In the remarks, the applicant has argued substantially that:

4) The office action used impermissible hind sight with the applicants disclosure to piece together the teachings of the prior art so that the invention is rendered obvious, on p. 22, ¶1:1-4.

Examiner's response:

4) In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). And the limitations, using HTML and HTTP, were well within the level of ordinary skill in the art at the time the claimed invention was made.

In the remarks, the applicant has argued substantially that:

5) Absent some teaching, suggestion or incentive in the prior art, May and AAPA cannot be properly combined to form the claimed invention, on p. 22, ¶ 1:5-6.

Examiner's response:

5) In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in

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the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

In this case, one would be motivated by the reasons stated above in the rejection of claims 11 and 13. Additionally, May, col. 1:6-8, "The present invention ... pertains particularly to the installation of software on a remote computing device.", and one of ordinary skill in the art at the time the claimed invention was made would have been well aware of the dominant remote networking/accessing technologies, HTML and HTTP, and would have wanted their system to be able to access the majority of remote computing systems by using these technologies.

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

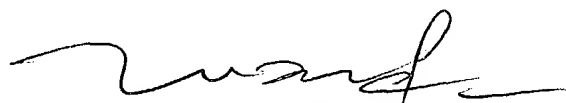
After October 25, 2004, the examiner can be reached at new telephone number (571) 272-3697, and the examiner's supervisor, Tuan Q. Dam can be reached on (571) 272-3695.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andre R. Fowlkes whose telephone number is (703)305-8889. The examiner can normally be reached on Monday - Friday, 8:00am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tuan Q. Dam can be reached on (703)305-4552. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ARF



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SUPERVISORY PATENT EXAMINER